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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/608,054

06/27/2003

Michael L.F. Chan

TRA-007

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03/22/2005

SCHNECK & SCHNECK

P.O. BOX 2-E

SAN JOSE, CA 95109-0005

EXAMINER

MILLER, BENA B

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,054

Applicant(s)

CHAN, MICHAEL L.F.

Examiner

Bena Miller

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/05/04
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is lack of proper antecedent basis for the claimed subject matter "said gift holding box is rectangular", as recited in claim 6, "said gift holding box is six-sided" as recited in claim 7.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter "said mailing box is uncovered for mailing" is not supported by the original specification and therefore, now constitute New Matter.

Claim 9 and 16-18 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 9, it is not clear if the specification whether mailing box is uncovered for mailing.

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Regarding claims 16-18, it is not clear how the functional recitations of the claims further structurally limit the claim. Further it appears that the claims, specifically claims 16 and 17, recite a method and claim 18, appears to recite a method of arranging the boxes.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 6, 9 and 16-18 are finally rejected under 35 U.S.C. 102(b) as being anticipated by McILHenney.

Regarding claim 1, McILHenney teaches in the figures a device for display of gifts comprising a gift holding box having a transparent surface (fig.1; col. 2, par.4), a mailing box having a cutout (1, col. 2, par. 2), and a removable opaque panel fitting inside the mailing box (7).

Regarding claim 2, McILHenney further teaches a display panel inside of the gift box (col. 2, par.4).

Regarding claim 4, McILHenney further teaches printing on the removable opaque panel in figure 2.

Regarding claim 6, McILHenney further teaches a rectangular gift holding box.

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Regarding claim 9 and 16-18 the Examiner takes the position that the functional recitations of the claims are inherently capable of being performed in the device of McILHenney.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5, 7 and 8 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over McILHenney.

McILHenney teaches in the figures most of the elements of the claimed invention. However, McILHenney does not disclose expressly that a metal sculpture mounted on the display panel, the mailing box including printing, an entirely transparent gift holding box, a transparent top and bottom section gift holding box. McILHenney indicates that removable panel 7 has identifying indicia, dispensing perishable articles in the package and a transparent upper portion gift holding box (combination of 11 and 12). At the time the invention was made, it would have been considered a matter of design choice to a person of ordinary skill in the art to apply indicia to the mailing box of McILHenney, to mount a metal sculpture on the display of McILHenney and to have the gift holding box of McILHenney entirely transparent and the top and bottom section transparent because Applicant has not disclosed that the features provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary

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skill in the art, furthermore, would have expected McILHenney display package and applicant's invention to perform equally well with either the dispensing perishable articles or the claimed metal sculpture because both would perform the same function of displaying the contents located in the device.

Therefore, it would have been prima facie obvious to modify McILHenney to obtain the invention as specified in claims 3 and 5 because such modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of McILHenney.

Claims 10-13 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over McILHenney in view of Büchler (US Patent 4,506,823).

McILHenney teaches in the figures most of the elements of the claimed invention except for sender identification lines printing, mailer identification lines printing, a meter stamp and a stamp. Büchler teaches a letter card (fig.2) having a space 25 for the application of stamps, a field 23 for the name and address of the recipients and a field 24 for the name and address of the sender. Further, the letter card has an insert 27 located therein (col. 8, par. 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply sender and mailer identification line printing as taught by Büchler to the panel of McILHenney for the purpose of mailing the gift to a person. Further, it would have been obvious to one having ordinary skill in the art to apply a stamp as suggested by Büchler to the panel of McILHenney for the purpose of mailing the gift to a person.

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Claims 10-13 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over McILHenney in view of Plotkin (US Patent 5,526,597).

McILHenney teaches in the figures most of the elements of the claimed invention except for a card and an envelope inside the gift holding box. Plotkin teaches in the figures a presentation system that is used for a presentation as a gift (Abstract, lines 1 and 2) wherein a card 24 and envelope 26 is located therein. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a card and envelope as suggested by Plotkin with the device of McILHenney for the purpose of enhancing the presentability of the content as a gift (col. 3, par. 2).

Response to Arguments

Applicant's arguments filed 11/22/04 have been fully considered but they are not persuasive. In response to Applicant's argument that McILHenney fails to teach a gift holding box having a transparent surface, the Examiner disagrees. The Examiner considers the combination of elements 11 and 12 as the gift holding box. Element 12 is wrapped and sealed in transparent paper 11, therefore the Examiner takes the position that it meets the claimed limitation. In reference to Applicant's argument of the rejections under 35 USC 103, the Applicant's attention is directed to the above rejection

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 571.272.4427. The examiner can normally be reached on Monday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bena Miller
Examiner
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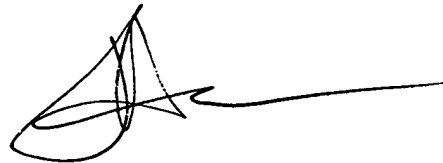
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bbm

March 17, 2005

A handwritten signature in black ink, consisting of a stylized, cursive 'J' followed by a horizontal line extending to the right.

JESSICA HARRISON
PRIMARY EXAMINER